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In re Application of FOLINO et al. :  
Application No.: 09/913,233 :  
PCT No.: PCT/CA00/00128 :  
Int. Filing: 10 February 2000 :  
Priority Date: 10 February 1999 : DECISION ON PETITION  
Attorney Docket No.: 19345-087835 : UNDER 37 CFR 1.47(a)  
For: GASKET INSTALLATION APPARATUS :  
:

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 27 November 2001.

### **BACKGROUND**

On 10 February 2000, applicant filed international application No. PCT//CA00/00128 which claimed priority of an earlier U.S. application filed 10 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 August 2000.

On 31 August 2000, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 10 August 2001.

On 10 August 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 27 September 2001, a Notification of Missing Requirements (FORM

PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration along with a surcharge for filing the oath or declaration after the thirty month period was required.

On 27 November 2001, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Salvatore J. Folino, on the grounds that the nonsigning inventor refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant, Peter Vert and Cecil Beauman on behalf of Salvatore J. Folino and a statement of facts under 37 CFR 1.47(a).

### DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the \$130 petition fee. Item (3) is satisfied with the statement of the last known address of non-signing inventor, Salvatore J. Folino. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

With respect to item (2), applicant must demonstrate that Salvatore J. Folino has refused to sign the declaration by conduct constituting a refusal to sign the declaration for the above referenced application..

#### Inventor's Refusal to Sign

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:....

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney....

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the

person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, Petitioner submitted a statement of facts in the form of a petition under 37 CFR 1.47(a) signed by U.S. patent agent, David J. Simonelli, dated 27 November 2001. The statement indicates that a letter was mailed to Mr. Folino on September 25, 2001 at his last known residence, with no response. A copy of the letter, which was attached to the petition, indicated that the "U.S. declaration and Power of Attorney document together with a copy of the application as filed" was sent to Mr. Folino's home address by Jeffrey T. Imai, Chief Patent Counsel at Magna International Inc. (parent corporation to applicant Tesma International, Inc.). A first hand statement from Mr. Imai was not provided. Accordingly, such allegation constitutes hearsay. Moreover, evidence that such letter was received by Mr. Folino has not been provided. For these reasons, petitioner has presented insufficient evidence to conclude that applicant/inventor Salvatore J. Folino has refused to sign the application.

### CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

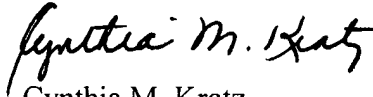
Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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